



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

KILLWORTH GOTTMAN HAGAN & SCHAEFF LLP
ONE DAYTON CENTRE, SUITE 500
DAYTON, OH 45402-2023

COPY MAILED

SEP 20 2004

In re Application of : **OFFICE OF PETITIONS**
Paul E. Burrows et al :
Application No. 09/966,163 : DECISION ON PETITION
Filed: September 28, 2001 : UNDER 37 CFR 1.78(a)(3)
Atty Dkt No. VIT 0012 PA/40926.13 :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed June 14, 2004, to accept an unintentionally delayed claim under 35 U.S.C. § 120 for the benefit of priority to prior-filed nonprovisional Application No. 09/427,138, as set forth in the amendment filed concurrently with the instant petition. This is also a decision on the concurrently filed petition under 37 CFR 1.47(a), which is being treated as a petition under 37 CFR 1.183 seeking waiver of the provisions of 37 CFR 1.67(a)(1), which states that a supplemental oath or declaration must be executed by all the named inventors.

The petition under 37 CF\$ 1.78(a)(3) is GRANTED.

The petition under 37 CFR 1.183 is GRANTED.

Discussion of Petition under 37 CFR 1.78(a)(3)

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
 - (2) the surcharge set forth in § 1.17(t); and
 - (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional.
- The Commissioner may require additional information

where there is a question whether the delay was unintentional.

The instant pending application was filed on September 28, 2001, and was pending at the time of filing of the instant petition. A reference to the above-noted, prior-filed nonprovisional application has been included in an amendment to the first sentence of the specification following the title, as required by 37 CFR 1.78(a)(2)(iii).

The instant nonprovisional application was filed after November 29, 2000, and the claim herein for the benefit of priority to the above-noted, prior-filed nonprovisional application is submitted after expiration of the period specified in 37 CFR 1.78(a)(2)(ii). Also, the reference to the above-noted, prior-filed nonprovisional application was submitted during the pendency of the instant nonprovisional application, for which the claim for benefit of priority is sought. See 35 U.S.C. § 120. Accordingly, having found that the instant petition for acceptance of an unintentionally delayed claim for the benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed nonprovisional application satisfies the conditions of 37 CFR 1.78(a)(3), the petition is granted.

The granting of the petition to accept the delayed benefit claim to the above-noted, prior-filed application under 37 CFR 1.78(a)(3) should not be construed as meaning that the instant application is entitled to the benefit of the above-noted, prior-filed application. In order for the instant application to be entitled to the benefit of the above-noted, prior-filed application, all other requirements under 35 U.S.C. § 120 and 37 CFR 1.78(a)(1) and (a)(2) must be met. Similarly, the fact that the corrected Filing Receipt accompanying this decision on petition includes the above-noted, prior-filed application should not be construed as meaning that applicant is entitled to the claim for benefit of priority to the above-noted, prior-filed application noted thereon. Accordingly, the examiner will, in due course, consider this benefit claim and determine whether the instant application is entitled to the benefit of the earlier filing date.

A corrected Filing Receipt, which includes the priority claim to the above-noted, prior-filed nonprovisional application, accompanies this decision on petition.

Discussion of Petition under 37 CFR 1.183

MPEP § 603, provides that, "[w]hen an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, it is possible that the requirement may be suspended or waived in accordance with 37 CFR 1.183." Therefore, the submission of a petition under 37 CFR 1.47(a) is not the appropriate avenue of relief in this instance. Accordingly, the petition has been treated as a petition under 37 CFR 1.183 to waive the provisions of 37 CFR 1.67(a)(1) for a supplemental declaration executed by less than all the named inventors who originally executed a declaration.

Petitioner requests acceptance of the supplemental declaration filed concurrently with the instant petition without the signature of previously signing inventor J. Chris Pagano on the basis that inventor Pagano has left the employ of Vitex Systems, Inc., and cannot be located to execute the supplemental declaration. The petition is accompanied by a "Declaration of Patricia L. Prior" setting forth the efforts made to locate inventor Pagano. In view thereof, petitioner now requests that the supplemental declaration be accepted without the signature of inventor Pagano.

Under the circumstances recounted in the petition, justice would be served by suspending the requirements of 37 CFR 1.67(a)(1). Accordingly, the substitute declaration received June 14, 2004 and executed by the five signing inventors and without the signature of previously signing joint inventor Pagano is accepted as a proper oath under 37 CFR 1.67(a)(1).

Any inquiries concerning this decision may be directed to the undersigned at (703) 305-8680.

This matter is being referred to Technology Center Art Unit 1772 for processing of the RCE and amendment filed August 5, 2004, including consideration by the examiner of applicant's entitlement to claim benefit of priority under 35 U.S.C. § 120 to the above-noted, prior-filed nonprovisional application.


Frances Hicks

Petitions Examiner
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy

ATTACHMENT: Corrected Filing Receipt